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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,939	12/29/2000	Masayoshi Oono	FUJI 119	6807

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EXAMINER

SMITHERS, MATTHEW

ART UNIT PAPER NUMBER

2137

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/749,939	<b>Applicant(s)</b> OONO, MASAYOSHI	
	<b>Examiner</b> Matthew B Smithers	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on May 28, 2000. It is noted, however, that applicant has not filed a certified copy of the JP2000-50855 application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. publication 2002/0073416 by Ramsey Catan.

Regarding claim 1, Ramsey Catan meets the claimed limitations as follows:

“A user authentication system comprising

authentication means for storing vital information about a user, confirming identity of a user and issuing authentication information on the user by comparing vital information about the user supplied through a network with the stored vital information, and

payment means which, upon receiving authentication information on the user issued by the authentication means, transmits the payment authorization for allowing the user to pay through the network to a provider which provides a network service to the user." see abstract; page 1, paragraph 0016 to page 2, paragraph 0018 and page 2, paragraph 0025 to page 4, paragraph 0049.

Regarding claim 2, Ramsey Catan meets the claimed limitations as follows:

"A user authentication system according to claim 1, wherein the authentication means obtains the vital information from the user who is to be registered through the network and conducts registration of the user by establishing correspondence between the vital information and the user." see page 1, paragraph 0016.

Regarding claim 3, Ramsey Catan meets the claimed limitations as follows:

"A user authentication system according to claim 1, wherein, when the user is a qualified payer, the payment means performs a notification to the authentication means through the network that the user is the qualified payer." see page 2, paragraph 0018.

Regarding claim 4, Ramsey Catan meets the claimed limitations as follows:

"A user authentication system according to claim 2, wherein the payment means obtains the vital information about the user from the user through the network, confirms that the user is a qualified payer and transmits the confirmation of qualified payer and the vital information to the authentication means through the network, and requests registration of the user." see page 1, paragraph 0016 and page 2, paragraph 0018.

Regarding claim 5, Ramsey Catan meets the claimed limitations as follows:

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"A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the user and transmits the authentication information to the user." see page 3, paragraph 0035 to paragraph 0041.

Regarding claim 6, Ramsey Catan meets the claimed limitations as follows:

"A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the transmission means and transmits the authentication information to the payment means." see page 2, paragraph 0022 to page 2, paragraph 0024.

Regarding claim 7, Ramsey Catan meets the claimed limitations as follows:

"A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the user and transmits the authentication information to the payment means." see page 3, paragraph 0035 to paragraph 0041.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. publication 2001/0051924 by Uberti.

Regarding claim 1, Uberti meets the claimed limitations as follows:

“A user authentication system comprising

authentication means for storing vital information about a user, confirming identity of a user and issuing authentication information on the user by comparing vital information about the user supplied through a network with the stored vital information, and

payment means which, upon receiving authentication information on the user issued by the authentication means, transmits the payment authorization for allowing the user to pay through the network to a provider which provides a network service to the user.” see abstract; page 2, paragraph 0023; page 4, paragraph 0050; page 7, paragraph 0079 to page 8, paragraph 0090.

Regarding claim 2, Uberti meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein the authentication means obtains the vital information from the user who is to be registered through the network and conducts registration of the user by establishing correspondence between the vital information and the user.” see page 4, paragraph 0050.

Regarding claim 3, Uberti meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user is a qualified payer, the payment means performs a notification to the authentication means

through the network that the user is the qualified payer.” see page 7, paragraph 0079 to page 8, paragraph 0090.

Regarding claim 4, Uberti meets the claimed limitations as follows:

“A user authentication system according to claim 2, wherein the payment means obtains the vital information about the user from the user through the network, confirms that the user is a qualified payer and transmits the confirmation of qualified payer and the vital information to the authentication means through the network, and requests registration of the user.” see page 7, paragraph 0079 to page 8, paragraph 0090.

Regarding claim 5, Uberti meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the user and transmits the authentication information to the user.” see page 5, paragraph 0063 to paragraph 0065 and page 7, paragraph 0079 to page 8, paragraph 0090.

Regarding claim 6, Uberti meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the transmission means and transmits the authentication information to the payment means.” see page 5, paragraph 0063 to paragraph 0065 and page 7, paragraph 0079 to page 8, paragraph 0090.

Regarding claim 7, Uberti meets the claimed limitations as follows:

"A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the user and transmits the authentication information to the payment means." see page 5, paragraph 0063 to paragraph 0065 and page 7, paragraph 0079 to page 8, paragraph 0090.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,474,548 granted to Montross et al.

Regarding claim 1, Montross meets the claimed limitations as follows:

"A user authentication system comprising



authentication means for storing vital information about a user, confirming identity of a user and issuing authentication information on the user by comparing vital information about the user supplied through a network with the stored vital information, and

payment means which, upon receiving authentication information on the user issued by the authentication means, transmits the payment authorization for allowing the user to pay through the network to a provider which provides a network service to the user.” see column 21, line 50 to column 22, line 31; column 23, lines 59-61 and column 28, line 64 to column 29, line 40.

Regarding claim 2, Montross meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein the authentication means obtains the vital information from the user who is to be registered through the network and conducts registration of the user by establishing correspondence between the vital information and the user.” see column 21, line 50 to column 22, line 31.

Regarding claim 3, Montross meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user is a qualified payer, the payment means performs a notification to the authentication means through the network that the user is the qualified payer.” see column 22, lines 20-31.

Regarding claim 4, Montross meets the claimed limitations as follows:

“A user authentication system according to claim 2, wherein the payment means obtains the vital information about the user from the user through the network, confirms that the user is a qualified payer and transmits the confirmation of qualified payer and the vital

information to the authentication means through the network, and requests registration of the user.” see column 21, line 50 to column 22, line 31.

Regarding claim 5, Montross meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the user and transmits the authentication information to the user.” see column 21, line 50 to column 22, line 31; column 23, lines 59-61 and column 28, line 64 to column 29, line 40.

Regarding claim 6, Montross meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the transmission means and transmits the authentication information to the payment means.” see column 21, line 50 to column 22, line 31; column 23, lines 59-61 and column 28, line 64 to column 29, line 40.

Regarding claim 7, Montross meets the claimed limitations as follows:

“A user authentication system according to claim 1, wherein, when the user receives an offer of a commodity or a service from the provider, the authentication means receives the vital information on the user from the user and transmits the authentication information to the payment means.” see column 21, line 50 to column 22, line 31; column 23, lines 59-61 and column 28, line 64 to column 29, line 40.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Martizen et al (US2002/0095386) discloses access management and control of multiple accounts by authorized users that have been previously authenticated.

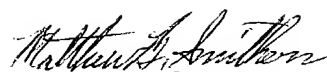
B. Hoffman et al (US 5,615,277) discloses a security system for authorizing access to a secured computer system after authenticating a user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T Caldwell can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Matthew B. Smithers".

Matthew B Smithers

Primary Examiner

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